

**REMARKS****I. REAL PARTY IN INTEREST**

The real party in interest is: Nokia Mobile Phones, Ltd.

**II. STATUS OF CLAIMS**

Claims 1-10 are pending in the application.

Claims 1-10 have been finally rejected.

**III. SUMMARY OF THE INVENTION**

In brief, the present invention is a cellular radio system (30), terminal (35) and method (Fig. 3) to realize cell prioritization. It features using priority data relating to the terminal (35) in order to favor at least one cell (32a, 33a) based on data specific to that terminal stored in and received from the network.

To the operator managing a cellular radio system the invention presents a wide range of possibilities to control cell priorities relating to one device. This is very advantageous, because from the network's point of view all terminals do not behave identically, so that the use of a single standard pattern for all devices would inevitably cause disadvantageous functions in some devices.

The invention as defined by the independent claims is:

1. A cellular radio system (30), which comprises terminals (35), cells (31a, 32a, 33a, 34a) and a network including stationary network equipment (36, 37), of which said terminals are arranged to set up and maintain radio communication with base stations (31, 32, 33, 34) in the cells, wherein at least one terminal (35) is arranged to favor at least one cell (32a, 33a) based on data specific to that terminal stored in and received from the network.

4. A cellular radio system terminal (35), which is arranged to set up and maintain radio communication with base stations (31, 32, 33, 34) in cells (31a, 32a, 33a, 34a) of the cellular radio system, wherein the terminal is arranged to favor at least one cell (32a, 33a) based on data specific to that terminal stored in and received from a network.

6. A method (Fig. 3) to realise cell prioritizing in a cellular radio system (30) comprising terminals (35), cells (31a, 32a, 33a, 34a) and a network including stationary network equipment (36, 37) of which said terminals are arranged to set up and maintain radio communication with base stations (31, 32, 33, 34) in the cells, wherein the method utilizes priority data relating to a terminal in order to favor at least one cell (32a, 33a) based on data specific to that terminal stored in and received from the network.

## V. Issues

1. Whether claims 1-3, 4, 6, and 7 are anticipated under 35 USC 102 by Chavez.
2. Whether claims 5 and 8 are obvious under 35 USC 103 on Chavez in view of Wang.
3. Whether claims 9 and 10 are obvious under 35 USC 103 over Chavez and Wang in view of ETSI.

#### VI. Grouping of Claims

The claims do not stand or fall together.

The claims are grouped as follows:

Group I: Claims 1-3, 4 and 6

Group II: Claims 5 and 8

Group III: Claims 9 and 10

#### VII. ARGUMENT

If one looks carefully at the embodiment described in column 3, lines 16-23, of Chavez, one notes that a key feature thereof is the ability of the network to associate each mobile terminal with a certain tenant. When a certain mobile terminal first attempts registering into the network, the wireless switching system "is responsive to the identification code of wireless

terminal 124 to examine an internal table to determine the tenant to which wireless terminal 124 is assigned" (column 3, lines 16-19). Once the wireless switching system has found an identification of the appropriate tenant, it transmits to the mobile station a tenant-specific list of allowable base stations. Note especially that the list so obtained would be exactly the same for each mobile station (or wireless terminal) assigned to the tenant in question. Typically, there is a larger number of wireless terminals (Chavez, column 2, line 64) and each tenant can designate, which wireless terminals (in plural!) are allowed to be served by certain dedicated bases stations (column 2, lines 52-54).

In other works, the only thing that is terminal-specific in the disclosure of Chavez is the entry in a table that is internal to the wireless switching system. Based on such terminal-specific information the network can select a tenant-specific preference list to be transmitted to the wireless terminal, but the network will never transmit the terminal-specific information because it is only useful to the wireless switching system for the purposes of finding out, which tenant has a certain terminal assigned to it.

On page 2 of the final rejection the Examiner points to a teaching of "wireless Terminal consulting an internal list of base stations on which it is allowed to register" in Chavez. The applicant does not contest the fact that Chavez's wireless terminal consults an internal list. However, such an internal list is not terminal-specific. If and when there are several terminals registered to a particular tenant, which is a condition expressly taught in Chavez as already pointed out above, each of these terminals receives exactly the same list from the network.

Chavez admittedly discloses storing terminal-specific information in a network. That terminal-specific information is the entry of the terminal identifier in a table that reveals which terminals belong to which tenant. Having obtained that information from the table, the network goes on to look for which base stations are allowable to the terminal of that tenant. The list of base stations is not terminal-specific, it is tenant-specific. Transmitting tenant-specific information to a particular terminal of that tenant does not make the information terminal-specific. It remains tenant-specific even when it resides stored in the memory of a terminal.

It is possible that the Examiner confuses the concepts of "terminal-specific" and "pertaining to a terminal". Terminal-specific means that the information has been created only that one specific terminal in mind. The information is unique to that terminal and potentially different from corresponding information specific to all other terminals. This is what the present invention is about. In Chavez and the like, the information about allowable base stations pertains to certain terminals, because it is common to these terminals that they all must behave according to the rules laid down in said pertaining information. But since the rules, i.e., the list of allowable base stations, is the same for all of these terminals, it is not terminal-specific.

The applicant's pending claims clearly require that network to store and transmit to the mobile terminal certain terminal-specific information. In particular, claims 1, 4 and 6 recite "based on data specific to that terminal stored in received from a network". These limitations are not anticipated by Chavez.

It is therefore requested that the rejection of claims 1-3, 4, 6 and 7 under 35 USC 102 on Chavez be withdrawn.

Further, since the terminal specific information received from the network is not suggested by Chavez, these claims are unobvious over it.

Wang also fails to disclose this feature. Thus adding it to the Chavez does not result in the present invention. Further, the Examiner has not shown where in the prior art there is a teaching or suggestion to combine these references in the first place as required by Ex parte Jones, 62 USPQ 2d 1206, 1208. Therefore the rejection of claims 5 and 8 under 35 USC 103 on these references should be withdrawn.

Similarly, ETSI fails to disclose the above feature. Thus adding it to Chavez and Wang does not result in the present invention. Also, there is no teaching or suggestion to combine it with the other references. Therefore the rejection of claims 9 and 10 on these references under 35 USC 103 should be withdrawn.

Thus, even if the references are somehow combined, the resulting combination will not have the advantage of allowing the system operator to set different priorities for different devices.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested, or at least an entry for appeal purposes as the claims are in better form. Should any unresolved issues remain, the Examiner is

invited to call Applicant's attorney at the telephone number indicated below.

This Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

Henry I. Steckler  
Henry I. Steckler (24, 139)  
Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800  
Customer No. 2512

May 15, 2003  
Date

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